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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/575,154

05/23/2000

Paul Lapstun

001US

9107

7590

11/25/2002

Kia Silverbrook
Silverbrook Research Pty Ltd
393 Darling Street
Balmain,
AUSTRALIA

EXAMINER

ST CYR, DANIEL

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/575,154

Applicant(s)

LAPSTUN ET AL.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Receipt is acknowledged of the amendment filed 9/13/02 in which claims 1-107 are amended.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the code data and the additional data are performed “**substantially simultaneously**”.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-54, and 58 drawn to the region and method claims 59-99 and 103-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman, US Patent No. 6,330,976, in view of Heckman et al, US Patent No. 5,291,243.

Dymetman et al disclose a marking medium area with encoded identifier for producing action through network comprising: a coded substrate supplier used to produce machine-readable markings. The coded substrate includes invisible markings on paper, which is nonetheless detected by the detection circuitry in a pointer device. Ultra-violet (UV) ink is used to print invisible markings on white paper. The coded substrate supplier could produce sheets of paper in different formats for different uses by the publishing industry. Each sheet can be processed through a specialized printing procedure which (1) assigns a fresh page-identifier (and possibly page-id-code) to the sheet, and (2) prints in UV ink machine-readable markings encoding the page-identifier (and possibly page-id-code) on the surface of the sheet. In standard trichromatic printing, three layers of coloured inks (yellow, magenta, and cyan) are superposed to produce all visible colours. Each layer filters one part of the light spectrum independently of the others. An encoded representation of the page-identifier, i.e. an item of data whose value uniquely identifies the page, within cell border 204, such as a first set of markings 208; and an encoded representation of location information, such as a location code uniquely defining the position of cell 202 within the page, within cell border 204, such as a second set of markings 210, illustratively smaller in size than first set 208 (see col. 11, line 5+, col. 13; figures 1-3, 7, 8).

Dimetman et al teach a document 102 printed on a code substrate 106 comprises a visible printed layer 104 (text, photograph image or any human readable information), an invisible machine-readable marking 108 sprinted on a sheet 110, but fail to disclose or fairly

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suggest the visible information and the invisible information are disposed on the surface substantially simultaneously.

Herkman et al disclose a system for electronically printed plural-color temper-resistant documents, wherein at least two colors are simultaneously printed on a security document (see col. 11, line 55+).

In view of Herkman et al's teachings, it would have been obvious for a person of ordinary skill in the art at the time the invention was made to modify the system of Dimetman et al so that both information could be simultaneously and/or separately printed each information onto the document. Such modification would enhance the system capability by expediting the printing process and would be more practical wherein the system could be used to print in-house secured documents with both information printed thereon and commercial documents having the invisible code to identify each page of the documents, which would make the system more effective. Therefore, it would have been an obvious extension as taught by Dimetman et al.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 55-57 and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al as modified by Heckman et al. The teachings of Dymetman et al as modified by Heckman et al have been discussed above.

Dymetman et al as modified by Heckman et al fails to disclose or fairly suggests the specific dimension of the region and the specific layout of the coded data for identifying the region, as set forth in the claims. However, such specific limitations fall within the engineering design choice for meeting specific design requirements, failing to provide any unexpected results. Therefore, it would have been obvious for an artisan to design the system of Dymetman et al as modified by Heckman et al into such specific design measurement for meeting customers' requirements.

Response to Arguments

9. Applicant's arguments with respect to claims 1-107 have been considered but are moot in view of the new ground(s) of rejection.

The phrase "substantially simultaneously" in the independent claims renders a new ground of rejection.

Further Remarks:

In response to the applicant's argument that Dimetman et al teaches away from simultaneously printing and teaches separate printing of coded sheets which are then supplied to a publisher, the examiner respectfully disagrees. This portion cited by the applicant, col. 11,

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lines 46-65, Dimetman is only providing an example of how the invention could be used. Figure 4 shows a security document where both visible and invisible information are printed thereon.

The applicant's argument is not persuasive. Refer to the rejection above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

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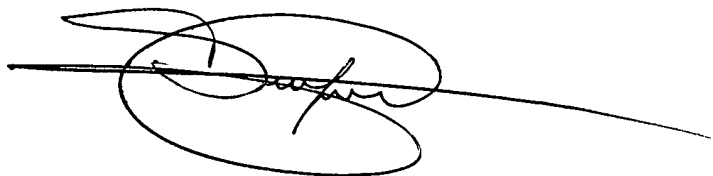
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr
Examiner
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DS
November 22, 2002

A handwritten signature in black ink, appearing to read 'Daniel St. Cyr', is written over a horizontal line. The signature is stylized with a large loop and a long horizontal stroke extending to the right.